

REMARKS/ARGUMENTS

Upon entry of the above amendment, claims 13 and 20 will have been amended for consideration by the Examiner. Thus, claims 13-26 remain pending. Applicant respectfully requests reconsideration of the outstanding rejections of the all claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicant would like to express his appreciation to the Examiner for the detailed Official Action provided.

Turning to the merits of the action, the Examiner has rejected claims 13-18 and 20-25 under 35 U.S.C. § 102 (e) as being anticipated by HAYASHI (U.S. Patent No. 6,862,114). The Examiner also has rejected claims 19 and 26 under 35 U.S.C. § 103 (a) as being unpatentable over HAYASHI in view of YOSHIDA et al. (U.S. Patent No. 5,031,179).

Applicant respectfully traverses the above rejections. As noted above, Applicant has amended claims 13 and 20 for consideration by the Examiner. Applicant respectfully traverses the above rejections based on claims 13-26 and will discuss said rejections with respect to the pending claims in the present application as will be set forth herein below. The newly submitted claims merely clarify the subject matter recited in the rejected claims, and do not narrow the scope of the claims, since it was already indicated that the e-mail is received from the mail server.

Applicants' claims 13-19 generally relate to a receiving Internet facsimile apparatus connectable to a mail sever via a network. The receiving Internet facsimile apparatus includes a communicator that receives, from the mail server via the network, an e-mail to which a plurality of pages of image data are attached, and a memory that stores the plurality of pages of the image data attached to the received e-mail. The receiving Internet facsimile apparatus further has a controller that determines whether the memory overflows during the reception of the e-mail, to stop receiving the e-mail when it is determined that the memory overflows. The controller also stores, in the memory, a predetermined page of the image data attached to the e-mail, when the e-mail is re-received from the mail server after the stop of receiving the e-mail, the predetermined page of the image data not being stored in the memory when the e-mail was previously received from the mail server. Claims 20-26 generally recite related methods.

In contrast, with respect to the rejection under 35 U.S.C. § 102, HAYASHI relates to an image data transmitting apparatus which stops both a reading operation and transmission operation of image data when a transmission trouble is detected, and resumes both the reading operation and the transmission operation after the documents are reset (see, e.g., col.13, lines 45-65).

Further, HAYASHI does not describe receiving operations in Figs.3-9. Rather, HAYASHI describes reading operations and transmission operations in Figs.3-9. HAYASHI also does not relate to an Internet facsimile apparatus, but

rather relates to a PSTN telephone line-based facsimile apparatus (see, e.g., col.17, lines 18-34).

In the “Response to Arguments” section of the Official Action, the Examiner argues that “while HAYASHI is describing an apparatus in transmission mode, it is clear that the said apparatus is also able to operate in receiving mode, and that there is a counterpart apparatus operating in said receiving mode. (HAYASHI- Fig.9A, col.16, lines 60-65)”

However, Applicant respectfully submits that the recitation portion merely teaches that a reception-side apparatus 1) receives, as an NSS signal, a value of the previous number of transmitted sheets, 2) stores all retransmission image data, and 3) deletes image data stored in the previous transmission (col.16, lines 60-65).

Thus, HAYASHI does not disclose the claimed receiving Internet facsimile apparatus which determines whether the memory overflows during the reception of the e-mail and stops receiving the e-mail when it is determined that the memory overflows. Rather, HAYASHI merely discloses a reception-side apparatus which receives, as an NSS signal, a value of the previous number of transmitted sheets, stores all retransmission image data, and deletes image data stored in the previous transmission. (see, e.g., col.16, lines 59-67).

Further, HAYASHI et al. do not disclose the claimed receiving Internet facsimile apparatus which stores, in the memory, a predetermined page of the image data attached to the e-mail, when the e-mail is re-received from the mail server after the stop of receiving the e-mail, the predetermined page of the

image data not being stored in the memory when the e-mail was previously received from the mail server. Rather, HAYASHI et al. merely disclose a reception-side apparatus which stores all retransmission image data (see, e.g., col.16, lines 62-63).

Additionally, while HAYASHI discloses receiving operations in Figs. 10 and 11. HAYASHI receives, from a transmitting apparatus, the number of the previously received sheets, the number being assigned in a NSS signal (Fig.10, S404) and determines whether currently received number of pages is larger than the number of the previously received sheets (Fig.10, S407), HAYASHI does not disclose determining whether the memory overflows during the reception of the e-mail and stops receiving the e-mail when it is determined that the memory overflows, as substantially recited in independent claims 13 and 20. Rather, HAYASHI merely compares currently received number of pages with the number assigned in the NSS signal. Thus, HAYASHI does not disclose the claimed receiving Internet facsimile apparatus which determines whether the memory overflows during the reception of the e-mail and stops receiving the e-mail when it is determined that the memory overflows.

Further, HAYASHI does not disclose the claimed receiving Internet facsimile apparatus which stores, in the memory, a predetermined page of the image data attached to the e-mail, when the e-mail is re-received from the mail server after the stop of receiving the e-mail, the predetermined page of the image data not being stored in the memory when the e-mail was previously received from the mail server. Rather, HAYASHI merely discloses a reception-

side apparatus which receives all image data including the previously transmitted image data and adds data indicating retransmission to the received image data when the previously transmitted image data is received (see, e.g., Fig.10 S408 and col.16, lines 9-23).

To the contrary, an embodiment of the present invention is directed to a receiving Internet facsimile apparatus which determines whether the memory overflows during the reception of the e-mail, stops receiving the e-mail when it is determined that the memory overflows, and stores, in the memory, a predetermined page of the image data attached to the e-mail, when the e-mail is re-received from the mail server after the stop of receiving the e-mail, the predetermined page of the image data not being stored in the memory when the e-mail was previously received from the mail server.

Further, HAYASHI is merely directed to a conventional facsimile apparatus, and HAYASHI does not contain any disclosure about an Internet facsimile apparatus. In this regard, the Examiner argues that "the features upon which Applicant relies (i.e., 'receiving Internet facsimile' , 'connectable to a mail server via a network') are not recited in the rejected claim(s)". However, Applicant submits that 'receiving Internet facsimile' and 'connectable to a mail server via a network' are recited in, e.g., lines 1-2 of claim 13.

Further, the Examiner argues that HAYASHI discloses a network interface or a network adapter coupled with the image transmitting apparatus (col.17, lines 25-30). However, Applicant submits that HAYASHI does not contain any disclosure regarding a receiving Internet facsimile apparatus that receives, from

a mail server, an e-mail to which a plurality of pages of image data are attached (col.17, lines 25-30).

In the "Response to Arguments" section, the Examiner notes that "[i]n response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (*i.e.*, 'receiving Internet facsimile', 'connectable to a server via a network') are not recited in the rejected claim(s)." Applicant notes that the preamble of independent claims 13 and 20 substantially recite "a receiving Internet facsimile connectable to a mail server via a network," and while a citation was not provided, Applicant assumes that the Examiner is relying on MPEP § 2111.02, which notes that the "preamble is not given the effect of a limitation unless it breathes life and meaning into the claim."

However, Applicant submits that at least since terms such as "e-mail" and "mail server" are used throughout the independent claims and refer back to the preamble, the phraseology in the preamble must be given patentable weight. *In re Stencel*, 4 USPQ2d 1071 (Fed. Cir. 1987). Thus, the preamble of independent claims 13 and 20 breathes life and meaning into these claims, and the claims dependent therefrom.

Also in the "Response to Arguments" section, the Examiner notes that the specification does not describe "how Internet connectivity changes the functionality and operation of the claimed invention with regard to storing received pages and retransmission of error data." Applicant respectfully

submits that one skilled in the art would readily understand how Internet connectivity changes the functionality and operation of the claimed invention.

Thus, Applicant respectfully submits that HAYASHI does not disclose the claimed receiving Internet facsimile apparatus connectable to a mail sever via a network, as claimed in claims 13 and 20. For the same reasons, HAYASHI neither discloses the claimed receiving Internet facsimile apparatus which receives, from the mail server, an e-mail to which a plurality of pages of image data are attached nor the claimed receiving Internet facsimile apparatus which stores the plurality of pages of the image data attached to the received e-mail.

On the other hand, the present claimed invention relates to a receiving Internet facsimile apparatus connectable to a mail sever via a network. The claimed receiving Internet facsimile apparatus receives, from the mail server, an e-mail to which a plurality of pages of image data are attached and stores the plurality of pages of the image data attached to the received e-mail.

Absent a disclosure in a single reference of each and every element cited in a claim, a prima facie case of anticipation cannot be made under 35 U.S.C. § 102. Since the applied reference fails to disclose each and every element recited in independent claims 13 and 20, these claims, and the claims dependent therefrom, are not anticipated thereby. Accordingly, the Examiner is respectfully requested to withdraw the rejection of the claims under 35 U.S.C. § 102.

Thus, the pending claims are distinguished over HAYASHI, as well as the other references of record, and it is respectfully submitted that the features

recited in Applicant's submitted claims 13-26 are not disclosed in HAYASHI cited by the Examiner.

With respect to the Examiner's rejection of dependent claims 19 and 26 under 35 U.S.C. § 103(a), YOSHIDA et al. relate to a data communication apparatus having an error retransmission mode. However, YOSHIDA et al. neither teach nor suggest a receiving Internet facsimile apparatus, as claimed in independent claims 13 and 20, from which claims 19 and 26 respectively depend. Rather, YOSHIDA et al. relate to a conventional facsimile apparatus. In other words, YOSHIDA et al. do not contain any disclosure regarding an Internet facsimile apparatus.

Further, YOSHIDA et al. do not disclose the claimed receiving Internet facsimile apparatus connectable to a mail sever via a network, as claimed in independent claims 13 and 20, from which claims 19 and 26 respectively depend. For at least the same reasons discussed above, YOSHIDA et al. also neither teach nor suggest the claimed receiving Internet facsimile apparatus which receives, from the mail server, an e-mail to which a plurality of pages of image data are attached, nor the receiving Internet facsimile apparatus which stores the plurality of pages of the image data attached to the received e-mail, as generally claimed in independent claim 13 and 20 from which claims 19 and 26 respectively depend.

Further, YOSHIDA et al. do not disclose the claimed receiving Internet facsimile apparatus or method which determines whether the memory overflows during the reception of the e-mail. Thus, YOSHIDA et al. do not disclose the

claimed receiving Internet facsimile apparatus or method which stops receiving the e-mail when it is determined that the memory overflows. YOSHIDA et al. also do not disclose the claimed receiving Internet facsimile apparatus which stores, in the memory, a predetermined page of the image data attached to the e-mail, when the e-mail is re-received from the mail server after the stop of receiving the e-mail, the predetermined page of the image data not being stored in the memory when the e-mail was previously received from the mail server, as generally claimed in dependent claims 19 and 26. Rather, YOSHIDA et al. merely disclose an error retransmission mode utilized in a conventional facsimile apparatus.

Further, YOSHIDA et al. neither disclose the claimed memory which stores a data amount of the image data stored in the memory when the receiving the e-mail was stopped nor the claimed receiving Internet facsimile apparatus which determines the predetermined page of the image data, based on the data amount of the image data stored in the memory, the predetermined page of the image data not being stored in the memory when the e-mail was previously received from the mail server, as generally claimed in independent claims 13 and 20, from which dependent claims 19 and 26 respectively depend. Thus, the pending claims are clearly distinguished over YOSHIDA et al.

Nevertheless, with respect to the Examiner's rejection of the dependent claims based on HAYASHI in view of YOSHIDA et al., Applicant submits that dependent claims 14-18 and 21-26 are respectively dependent from allowable independent claims 13 and 20, which are allowable for at least the reasons

discussed supra. Thus, these dependent claims are also allowable for at least the reasons discussed supra. Further, all dependent claims set forth a further combination of elements neither taught nor disclosed by any of the applied references.

Therefore, it is respectfully submitted that the features recited in Applicant's submitted claims 13-26 are not disclosed in YOSHIDA et al. cited by the Examiner. The pending claims are also submitted to be patentable over the Examiner's proposed combination, since neither HAYASHI nor YOSHIDA et al., either alone or in any proper combination discloses the features recited in Applicants' claims 13-26.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections and an indication of the allowability of all the claims pending in the present application, in due course.

Although the status of the application is after final rejection, Applicant submits that entry of the amendment is proper under 37 C.F.R. § 1.116. In particular, no new matter issues are being presented and no new claims are being submitted. It is believed that the Examiner has searched and considered the claim limitations as they were discussed in the specification. The Examiner is respectfully requested to exercise his discretion in this regard.

SUMMARY AND CONCLUSION

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has amended some rejected claims and has re-submitted the pending claims for consideration by the Examiner. With respect to the rejected claims, Applicant has pointed out the features thereof and have contrasted the features of the rejected claims with the disclosure of the references. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully requests an indication of the allowability of all the claims pending in the present application in due course.

Applicant notes that this amendment is being made to advance prosecution of the application to allowance, and no acquiescence as to the propriety of the Examiner's rejection is made by the present amendment. The amendments to the claims have not been made for a purpose related to patentability, but rather are clarifying amendments that are cosmetic in nature by rendering explicit what was already implied in these claims, *i.e.*, that the email is received from the mail server via the network. The amendments to the claims should thus be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto. Accordingly, this amendment should not be considered a decision by Applicants to narrow the claims in any way.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

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